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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,284	10/17/2000	Robert J. Johnson	F-147	2197

7590 10/21/2002
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Intellectual Property and Technology Law Dept
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EXAMINER

LEE, SEUNG H

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,284

Applicant(s)

JOHNSON ET AL.

Examiner

Seung H Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the response filed on 9 August 2002, which has been entered in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 6, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,244,763, of the record) in view of Block (US 6,010,156, of the record) and Wolfram (US 5,051,565).

Miller teaches the method for printing an indicia on a label in a system including reading a label configuration file (10, 40, 60) (see Fig. 1 - 3, and 5), selecting an amount of labels to be printed, printing the amount of labels (94) using two dimensional barcode corresponding to the United States Postal Service (USPS) Indicia-Based Information Program (IBIP) (see Fig. 5; col. 1, lines 18 - 33; col. 7, lines 5 - 10),

However, Miller fails to teach or fairly suggest that the selecting a label stock, reading a definition file associated with the selected label stock, and tagging the label pair with a unique identifying mark (i.e., hash line) in a predetermined inconspicuous area of the label.

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Block teaches the label pair comprising a destination address label having a destination address (313) and a corresponding an indicia label or delivery point barcode (315) is printed, coding identifier (319) contains USPS readable data in which produced the label which a plurality of tick hashing line, printing labels based on proper postage amount for items to be mailed (see Fig. 3A; col. 1, lines 6-25; col. 4, lines 21-57; col. 5, lines 6-21). And Wolfram teaches duplicated labels (19) in which the labels are attached to a boarding pass (14A) and baggage tags (13) (see Fig. 2; col. 3, lines 46-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Block and Wolfram to the teachings of the Miller in order to identify indicia using the USPS standard facing identification mark. Moreover, such modification would improve readability of the label since the destination address label includes the human readable address for operator(s) and bar-coded address for scanning device. Furthermore, such modification would provide easier sorting means for sorting mail piece based on the value/number of hash lines, that is, hash lines can be determined to delivery location (i.e., payment department, customer service department, product inquiry department) automatically using a OCR reader and/or sorting personnel, and therefore an obvious expedient. Although, Miller as modified by Block and Wolfram fails to particularly teach the label configuration file is indicative of one or more label stocks and selecting a label stock for printing indicia on the label, the system of Miller/Block/Wolfram obviously includes a software/template to choose/select appropriate label layout among various layouts (Fig. 1 to 3) for

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proper printout of the label indicia to further accommodate the size of the box or the size of the item to be placed thereupon (i.e., the system would not print-out a label which is twice as big as the item/box to attach the label thereon, etc), and therefore an obvious expedient.

4. Claims 2, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as modified by Block and Wolfram as applied to claim 1 above, and further in view of Fougere et al. (US 4,743,747, of the record)(hereinafter referred to as 'Fougere').

The teachings of Miller/Block/Wolfram have been discussed above.

Although, Miller/Block/Wolfram teach the printing method of label, they fail to teach or fairly suggest that the barcode is encrypted and the coding identifier is an alphanumeric character.

Fougere teaches the encrypted alphanumeric character (42) or the barcode (42A) for retrieving information (i.e., postage, address, etc.) (see Figs. 2 and 3; col. 4, line 53- col. 5, line 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fougere to the teachings of Miller/Block/Wolfram in order to provide an improved security means by encrypting of the destination barcode for preventing an authorized personnel from knowing the destination address. Moreover, such modification (i.e., alphanumeric character as a coding identifier) would provide easier means for tracking the mail since the mail is scanned into the system at every major

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transaction center using unique tracking code or identification number.

Furthermore, such modification (i.e., alphanumeric character as a coding identifier) would provide an alternative method of reading the identification of the mail due to the fact that when the reading machine is not working properly, the alphanumeric coding identifier or tracking code would provide proper identification of mail, and therefore an obvious expedient.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as modified by Block and Wolfram as applied to claim 1 above, and further in view of Bone, Jr. (US 5,270,522, of the record).

The teachings of Miller/Block/Wolfram have been discussed above.

Although, Miller/Block/Wolfram teach the printing method of label, they fail to teach or fairly suggest that the label pair includes a color-coding of the label.

Bone, Jr. teaches the barcode label and/or human readable characters are printed in color (see Fig. 12; col. 6, lines 1-10, col. 13, lines 28-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the color printing of indicia as taught by Bone, Jr. to the method of printing indicia on the label as taught by Miller/Block/Wolfram in order to have a better recognition/verification of the identifying mark under a different light conditions (i.e., dark and/or bright lighting conditions). Furthermore, such modification (i.e., printing indicia in color) would have been an obvious design variation, failing to provide any unexpected results, well within the ordinary skill in the art.

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6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as modified by Block and Wolfram as applied to claim 1 above, and further in view of Klippert (DE 32 33 005, of the record).

The teachings of Miller/Block/Wolfram have been discussed above.

Although, Miller/Block/Wolfram teach the printing method of label, they fail to teach or fairly suggest that the coding identifier is a watermark.

Klippert teaches the watermark is imprinted on the postage stamp (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the identifying mark such as watermark as taught by Klippert to the teachings of the Miller/Block/Wolfram in order to provide an improved and an enhanced means for validating/authenticating the postage stamp by examining the watermark on the stamp. Furthermore, such modification would prevent an unauthorized copy by providing a certain phrase and/or word (e.g., VOID, Copied Document, etc.) when the printed label has been copied, and therefore an obvious expedient.

Response to Arguments

7. Applicant's arguments filed 9 August 2002 have been fully considered but they are not persuasive.

In response to the applicant's argument that "The cited references do not teach or fairly suggest tagging each label of the label pair with an identifying mark" (see page 4, line 16+), the Examiner respectfully provides the Wolfram

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reference wherein the Wolfram teaches the tagging of the boarding pass and the baggage tags with unique machine readable code as discussed in paragraph 3 above.

In response to applicant's argument that Klippert is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Klippert simply provide an evidence of using watermark on the stamp. Therefore, when interpreting the claimed limitations as broadly as is reasonably possible, the combination of the teachings of Miller/Block/Wolfram (as described above) and the general knowledge available to one of ordinary skill in the art at the time of the invention (as evidenced by Klippert) meets the claimed limitation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Sansone et al [US 6,142,380], Sansone et al [US 5,292,008], Berson [US 5,929,415], Dolan et al [US 5,806,421], Fabel [US 6,209,920] disclose a postal indicia and printing the same.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications

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where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Seung H. Lee
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October 10, 2002



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800